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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,348	12/08/2000	Eric Schneider		2277

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EXAMINER

PWU, JEFFREY C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,348

Applicant(s)

SCHNEIDER, ERIC

Examiner

Jeffrey C. Pwu

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-56 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 41-56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 42 and 49 recites the limitation "the group of telephone number". There is insufficient antecedent basis for this limitation in the claim.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 41-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Uhl et al. (U.S. 6,292,709).

5.

Uhl et al. teaches claims :

41. A mail piece including a plurality of markings, for delivery to a recipient from a sender, comprising:

a first marking including a sender address and a recipient address; (Fig.7, "Sender, sender street, 33333 Sender City"; "Recipient old street 145, 1234 old city")

a second marking indicating that the mail piece is undeliverable to the recipient (Fig.7, "FORWARD New Street 99, 65676 New City"); and,
a third marking including access information for accessing a locator service via a communication network to assist the sender in locating current contact information for the recipient. (Fig.7, "barcode for the new address")

44. A mail piece, as set forth in claim 43, wherein said third marking is marked upon the mail piece at any time after said second marking is marked and before said mail carrier returns the mail piece to said sender address. (Fig.7)

45. A mail piece, as set forth in claim 41, wherein said sender address is a sender postal address and said recipient address is a recipient postal address. (Fig.7)

46. A method for returning to a sender mail for a recipient, comprising the steps of receiving mail including a sender address and a recipient address;
determining that the mail is undeliverable to the recipient;
adding to the mail access information for accessing a locator service via a communication network to assist the sender in locating current contact information for the recipient; and
delivering the mail to said sender address. (Claim 46 is similarly rejected as in claim 41)

47. A method for returning to a sender mail for a recipient, as set forth in claim 46, wherein said sender address is a sender postal address and said recipient address is a recipient postal address. (Fig.7)

48. A method for returning to a sender mail for a recipient, as set forth in claim 46, further including instructing a mail carrier to return the mail to said sender address. (Fig.12, "[] refusal to accept [x] moved with forwarding address [] recipient has died/resolved")

50. A method for returning to a sender mail for a recipient, as set forth in claim 49, wherein said step of adding to said mail access information further includes the step of marking said access information upon said mail. (fig.12)

51. A method for returning to a sender mail for a recipient, as set forth in claim 49, wherein said step of adding to said mail access information further includes the step of stamping said access information upon said mail.(fig. 12, "city of sender, your shopping paradise")

52. A method for returning to a sender mail for a recipient, as set forth in claim 49, wherein said step of adding to said mail access information further includes the step of inking said access information upon said mail. (figs. 9-12)

53. A method for returning to a sender mail for a recipient, as set forth in claim 50, wherein the mail includes an envelope and said step of marking said access information upon said mail includes the step of marking said access information upon said envelope. (figs. 9-12)

54. A method for returning to a sender mail for a recipient, as set forth in claim 51, wherein the mail includes an envelope and said step of stamping said access information upon said mail includes the step of stamping said access information upon said envelope. (figs. 9-12)

55. A method for returning to a sender mail for a recipient, as set forth in claim 52, wherein the mail includes an envelope and said step of inking said access information upon said mail includes the step of inking said access information upon said envelope. (figs. 9-12)

56. A method for returning to a sender mail for a recipient, as set forth in claim 46, wherein the mail includes an envelope and said step of adding to said mail access information includes the step of placing an advertisement for a locator service upon said envelope. (fig. 12, "city of sender, your shopping paradise")

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Response to Arguments

6. Applicant's arguments with respect to claims 41-56 have been considered but are moot in view of the new ground(s) of rejection.

With respect to applicant's argument that Uhl does not teach "assisting the sender after mail is returned to sender". The examiner respectfully disagrees. In contrary, Uhl teaches a method of assisting senders a letter to be forwarded or

returned. Figs. 8-12 show a mail item to be returned following processing in the online system for automatic processing of items to be forwarded and returned.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey C. Pwu whose telephone number is 571-272-6798.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



10/16/05
JEFFREY PWU
PRIMARY EXAMINER